

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte XIA LUO, SCOTT M. EVANS,
and WILLIAM J. WORTHEN

Appeal No. 2005-2095
Application No. 09/456,110

ON BRIEF

MAILED

AUG - 5 2005

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before GARRIS, OWENS, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-3.

The subject matter on appeal relates to a method for treating a stroke patient which comprises advancing a heat exchange catheter into a central venous vein of the patient and inducing hypothermia with the catheter. This appealed subject

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matter is adequately represented by claim 1, the sole independent claim on appeal, which reads as follows:

1. A method for treating stroke patients, comprising the acts of:

identifying a stroke patient for treatment;

advancing a heat exchange catheter into said patient wherein said heat exchange catheter is advanced into a central venous vein of said patient; and

inducing hypothermia using said heat exchange catheter.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Dato	3,425,419	Feb. 4, 1969
Fox	6,090,132	Jul. 18, 2000
Ginsburg	5,486,208	Jan. 23, 1996
Dobak, III et al. (Dobak)	6,254,626	Jul. 3, 2001

(filed Dec. 16, 1998)

All of the appealed claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dato or Ginsburg in view of the Fox and Dobak references.¹

Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning these rejections, we refer to the brief and to the answer for a complete exposition thereof.

¹ As indicated on page 3 of the brief, the appealed claims stand or fall together. Therefore, in assessing the merits of the above noted rejection, it is appropriate to focus only on independent claim 1.

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OPINION

We will sustain each of the rejections advanced on this appeal.

We fully agree with the findings of fact, conclusions of law and rebuttals to argument expressed by the examiner in his answer. Accordingly, we hereby adopt these findings, conclusions and rebuttals as our own. We add the following comments for emphasis.

For the reasons fully detailed in the answer, it would have been obvious for one of ordinary skill in this art to use the Dato or Ginsburg method of inducing hypothermia in a patient as a method for treating a stroke patient specifically in view of Fox's teaching that hypothermia is one of the most effective therapies known for treating stroke (e.g., see lines 22-34 in column 1). In this way, a known stroke treatment, namely, hypothermia would have been achieved via the use of a heat exchange catheter technique evinced by Dato or Ginsburg to be known in the prior art as effective for inducing hypothermia. Because the aforenoted treatment and technique are known in the prior art as effective, the artisan would have reasonably expected success in combining these reference teachings in the

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manner proposed by the examiner. See In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988).

The appellants argue that an artisan would not have been motivated to combine the teachings of Dato or Ginsburg with Fox in the manner discussed above. Indeed, the appellants urge that Fox teaches away from such a combination because the hypothermia inducing technique specifically taught by Fox for treating stroke involves heating the hypothalamus, rather than using a heat exchange catheter, to lower the body temperature of the patient. Contrary to the appellants' belief, the Fox patent does not "teach away" from the examiner's proposed combination simply because patentee uses an alternative technique for inducing hypothermia. See In re Berg, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003). As explained by the examiner (e.g., see pages 5-8 of the answer), the applied reference teachings as a whole evince that an artisan would have selected a hypothermia inducing technique, including the respective techniques of Dato and Ginsburg, depending upon which would be more suitable under a particular set of circumstances. Stated otherwise, the mere fact that Fox recommends his new hypothermia inducing technique does not lead to the obliteration of the other hypothermia inducing

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techniques taught by Dato and Ginsburg. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

The appellants also argue that the examiner's proposed combination of Dato or Ginsburg with the Dobak reference would not have been obvious particularly since Dobak specifically refers to the Dato device as having the negative effects of total body hypothermia (e.g., see lines 48-67 in column 1 and lines 1-8 in column 2). In one sense, this argument is not relevant to the issues before us on this appeal since the Dobak reference has been relied upon by the examiner with respect to nonargued dependent claims 2 and 3 only (see the two full paragraphs on page 8 of the answer). To the extent appellants believe Dobak militates against the previously reviewed combination of Dato or Ginsburg with Fox, we have fully considered all of the disclosures in the prior art applied by the examiner. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

This consideration leads us to determine that the examiner's obviousness conclusion regarding appealed claim 1 is not erroneous simply because Dobak teaches that total body hypothermia (i.e., of the type taught by Dato or Ginsburg) possesses undesirable side effects. The mere presence of undesirable side effects is neither uncommon nor conclusive of

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nonobviousness. Indeed, it is likely that the localized hypothermia technique of Dobak also possesses undesirable side effects. Consistent with our earlier observation, the mere fact that Dobak recommends his localized hypothermia technique and describes total body hypothermia techniques as having undesirable side effects does not lead to the obliteration of all total body hypothermia techniques. Beattie, 974 F.2d at 1312, 24 USPQ2d at 1042.

For the reasons set forth above and particularly those expressed by the examiner in his answer, it is our ultimate determination that the applied reference evidence establishes a prima facie case of obviousness with respect to the independent claim on appeal which the appellants have failed to successfully rebut with argument or evidence of nonobviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain, therefore, the examiner's section 103 rejection of all appealed claims as being unpatentable over Dato or Ginsburg in view of Fox and Dobak.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Bradley R. Garris
Bradley R. Garris)
Administrative Patent Judge)
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